

Sir:

REMARKS

Please make the herein requested amendments to the above identified application and examine the application as amended in view of the herein remarks. A new Information Disclosure Statement is also included herewith.

- 1) The 230 claims as amended on June 18, 2003 remain the claims presented for examination.
- 2) Please find herewith a Substitute Specification per 37 CFR 1.125 to replace the present specification as amended on June 18, 2003. A clean version for entering and a marked up version showing all of the changes are herewith included.
- 3) The Substitute Specification includes No new matter. During licensing negotiations Applicant was accused by a third party's legal counsel of changing the scope of the specification of application 09/721,090 from application 08/677,378. Applicant does not agree that he changed the scope of the application, but Applicant is here submitting the Substitute Specification to closely align the instant application with its Grand parent application 08/677,378.
- 4) For the purposes of overcoming references by way of receiving an earlier effective filing date through the 35 USC 120 Priority claim made on page 1 of the Substitute Specification, please consider the following:

U.S. Patent Application 09/721,090 now Patent 6,310,606 is the Child of U.S. Patent Application 08/677,378 now Patent 6,222,525. The present Application 09/893,292 is a Grand Child of Application 08/677,378. U.S. Patent Application 08/677,378 is a continuation-in-part of U.S. Patent Application 08/393,459 now Patent 5,565,891 and a continuation-in-part of U.S. Patent Application 07/847,619 now Patent 5,589,828.

Applicant's U.S. Patent 6,222,525 was originally incorporated by reference into the present application. The herewith Substitute Specification is the specification of U.S. Patent 6,222,525 with the addition on pages 15 and 42 of the wording:

"An example of an active tactile feedback means is an electric motor with shaft and offset weight within a handle for providing active tactile feedback, as shown in drawing FIG. 21".

NO NEW MATTER

During the prosecution of U.S. Patent Application 09/721,090 now Patent 6,310,606 an issue arose concerning whether new matter was entered or not and whether there was a continuing teaching of an active tactile feedback means being "a motor and offset weight" from applicant's U.S Patent Application 07/847,619 to Application 08/677,378 to Application 09/721,090. The Patent Examiner was Examiner J. Brier, a highly skilled and highly experienced Examiner, with more than 1,000 issued patents for which he had been the Patent Examiner. The ultimate decision by Examiner Brier was that a motor and offset was fully supported and taught for tactile feedback in combination with the various elements in the continuing chain of the patent applications U.S Patent Application 07/847,619 to Application 08/677,378 to Application 09/721,090 and that regarding the motor and offset weight no new matter had been added.

A summary of the '090 application decision process regarding the motor and offset weight is in the three paragraphs following:

The wording "active tactile feedback means" was originally in the Application 08/677,378 of Patent 6,222,525 . The wording "an electric motor with shaft and offset weight" was not originally typed into the specification of Pat. 6,222,525, but the motor, shaft and offset weight were originally clearly shown in broken lines in drawing Fig. 21 and referred to as "active tactile feedback means" in Pat. '525.

Application No. 09/721,090 (now Pat. 6,310,606) basically, with some small changes, used the specification of Pat. 6,222,525 and was thus also lacking the wording regarding the motor, shaft and offset weight in the written portion. The wording regarding the motor, shaft and weight was required to be inserted into the written portion of the specification of U.S. Patent Application No. 09/721,090 by Examiner J. Brier in the 07/23/01 Office Action. Application 09/721,090 was filed by Applicant as a Continuation of Application 08/677,378 (now Pat. 6,222,525). During examination of Application 09/721,090, Examiner Brier identified claims having active tactile feedback some of which included the wording motor, shaft and offset weight. Examiner Brier reminded Applicant that Application 09/721,090 was said to be a "Continuation" of Application 08/677,378. Examiner Brier stated that parent Application 08/677,378 must include the active tactile

feedback (motor) or the Application 09/721,090 would be a "Continuation-in-Part" as opposed to a "Continuation" of parent Application 08/677,378 . See the Office Action of 6/18/01 pages 2-3 points 1-6, mostly point 6, of Application 09/721,090 where Examiner Brier advises Applicant of the requirement to show the active tactile feedback motor in the parent Application 08/677,378 or alternatively the Application 09/721,090 is a Continuation-in-Part Application of Application 08/677,378.

In a June 29, 2001 telephone interview between Applicant and Examiner Brier wherein several issues were addressed, Applicant directed the Examiner's attention to the fact that the motor, shaft and weight were shown in the drawings and described with words in Applicant's earlier U.S. Application 07/847,619 now Patent 5,589,828 to which a 35 USC 120 Priority claim was made for Application 08/677,378. Examiner Brier's attention was specifically directed to Patent 5,589,828, column 6 part 234 and 234a, and drawing Figs. 2 and 7. Examiner Brier's attention was then directed to drawing Fig. 21 in the later filed Application 08/677,378 (Pat. 6,222,525) wherein the motor, shaft and offset weight of Pat. '828 are clearly illustrated in a hand holdable part "300" and referred to as active tactile feedback means several times in the Application '378 specification. Applicant believes Examiner Brier correctly determined the addition of the wording "motor, shaft and offset weight" did not constitute the addition of new matter to Application 09/721,090 relative to the parent Application 08/677,378. Examiner told Applicant that after examining the evidence, the "motor, shaft and offset weight" were fully supported through out the continuing chain of Applicant's Patent Applications, thus he would not require Applicant to change the Priority claim from "Continuation" to "Continuation-in-Part".

The present Examiner is respectfully requested to respond in writing if he does not believe Patent 6,222,525 when filed effectively disclosed and taught the motor, shaft and offset weight providing active tactile feedback.

5) Please find herewith a detailed Information Disclosure Statement. Please do not hesitate to contact Applicant if any assistance or additional information is needed.

AMENDMENTS

Please enter the herewith Substitute Specification using it to replace the present specification as amended on June 18, 2003.

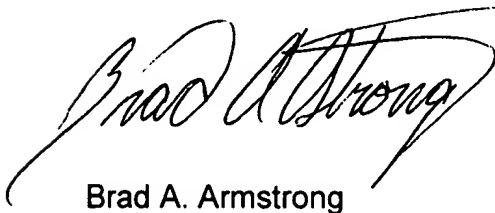
REMARKS

The Examiner is invited to please telephone Applicant regarding any matter which Applicant may be of assistance.

Phone: 530 877 3429 or 775 721 6958

Thank you.

Respectfully,

A handwritten signature in cursive script, appearing to read "Brad A. Armstrong".

Brad A. Armstrong

Date: *Dec. 5, 2003*